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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/789,096
Filing Date: February 27, 2004
Appellant(s): PATEL, NIRANJAN

Aziz M. Ahsan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 November 2007 appealing from the Office action mailed 22 September 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 22 November 2006 has not been entered. Though the Advisory Action mailed 20 December 2006 was incomplete in that neither box a) or b) in item 7 was checked, the Advisory Action indicated in item 3 that the amendment would not be entered.

(5) Summary of Claimed Subject Matter

37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and

the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The examiner agrees with the Appellant's summary of the claimed subject matter as presented prior to the final office action.

The examiner disagrees with the Appellant's summary of the claimed subject matter as contained in the After Final Amendment received 22 November 2006, because the claims contained therein have not been entered.

(6) Grounds of Rejection to be Reviewed on Appeal

The first three statements of the ground of rejection to be reviewed on appeal are correct.

The fourth statement of the ground of rejection to be reviewed on appeal is incorrect. Appellant's brief presents arguments relating to an Advisory Action mailed 20 December 2006. An Advisory Action is not a ground of rejection. Instead, this issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-18 appears on page 32 of the Appendix to the appellant's brief. The minor errors are as follows: the claims contained on pp. 35-37 have not been entered and therefore are not under consideration at this time.

(8) Evidence Relied Upon

2,444,748

Parissi

07-1948

(9) Grounds of Rejection

The following ground(s) of rejection presented in the Final Office Action mailed 22 September 2006 are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones, Jr., US 5,402,396 (hereafter Jones).

a. Regarding claim 1, Jones teaches an apparatus, comprising an alarm-clock (10, Fig. 1), wherein said alarm-clock has at least one button (24, Fig. 1) and at least one alarm, and wherein when said alarm is set said alarm button radiates light ("buttons 24, 26 be rendered translucent and for light produced by the night light be allowed to be transmitted therethrough," col. 2, 11. 57-59). The examiner considers the limitation "to provide a visual reminder that the alarm has been set" to be functional language that is satisfied by having a button radiating light when an alarm is set. Whether the user is visually reminded that an alarm is set is immaterial to the structure and operation of the alarm clock apparatus.

b. Regarding claim 2, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein at least one luminescent device (28, Fig. 1) is

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associated with said alarm button, and wherein said luminescent device is selected from a group consisting of an incandescent bulb ("two bulbs," col. 2, 1.30).

c. Regarding claim 3, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein material for said alarm button is selected from a group consisting translucent material ("buttons 24, 26 be rendered translucent and for light produced by the night light be allowed to be transmitted therethrough," col. 2, 11. 57-59).

d. Regarding claim 4, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein at least one electronic component is associated with said alarm-clock, and wherein said electronic component is selected from a group consisting of an AM-FM radio (14, Fig. 1).

e. Regarding claim 5, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein said alarm-clock is operated using an alternating current (32, Fig. 2).

f. Regarding claim 6, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein said at least one button is selected from a group consisting of a button that protrudes from the alarm-clock housing (24, Fig. 1).

g. Regarding claim 8, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein the display of said alarm-clock is selected from a group consisting of a digital display (12, Fig. 1).

h. Regarding claim 9, Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein at least one means is provided to control light radiating from said alarm-clock (30, Fig. 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones.

Jones teaches all that is claimed as discussed in the rejection of claim 1 above. Jones also teaches wherein said alarm-clock is operated using an alternating current (32, Fig. 2) from a "source of AC electricity" (col. 4, 1. 22). Jones is silent as to the characteristics of the alternating current the clock is designed to use.

It is within the knowledge of a person having ordinary skill in the art that the characteristics of residential electrical power available in the United States to power devices such as the clock comprise 110/120 VAC at 60 Hz.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones such that it uses 110/120VAC power, because a person having ordinary skill in the art would recognize that the problem of providing power to the alarm clock would be solved if the clock were able to use the electrical power readily

available in the US, and that a clock that uses readily available electrical power would have greater commercial appeal than one which required a voltage converter.

5. Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Parissi, US 2,444,748 (hereafter Parissi).

a. Regarding claim 10:

Jones teaches an apparatus, comprising an alarm-clock (10, Fig. 1), wherein said alarm-clock has at least one button (24, Fig. 1) and at least one alarm, and wherein when said alarm is set said alarm button radiates light ("buttons 24, 26 be rendered translucent and for light produced by the night light be allowed to be transmitted therethrough," col. 2, 11. 57-59). The examiner considers the limitation "to provide a visual reminder that the alarm has been set" to be functional language that is satisfied by having a button radiating light when an alarm is set. Whether the user is visually reminded that an alarm is set is immaterial to the structure and operation of the alarm clock apparatus.

Jones does not teach wherein when said alarm is activated said alarm button radiates a flashing light.

Parissi teaches a clock with visible alarm means (10, Fig. 1) that flashes when the alarm is activated (col. 4, 11. 9-11). The flashing is effective to alert hearing impaired users that the alarm has been activated (col. 1, 11.4-6).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones wherein when said alarm is activated said alarm button radiates a flashing light, because Parissi teaches that a flashing alarm light is advantageous to alert hearing impaired users that the alarm has been activated.

b. Regarding claim 11, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein at least one luminescent device (28, Fig. 1) is associated with said alarm button, and wherein said luminescent device is selected from a group consisting of an incandescent bulb ("two bulbs," col. 2, 1. 30).

c. Regarding claim 12, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein material for said alarm button is selected from a group consisting translucent material ("buttons 24, 26 be rendered translucent and for light produced by the night light be allowed to be transmitted therethrough," col. 2, 11. 57-59).

d. Regarding claim 13, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein at least one electronic component is associated with said alarm-clock, and wherein said electronic component is selected from a group consisting of an AM-FM radio (14, Fig. 1).

e. Regarding claim 14, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein said alarm-clock is operated using an alternating current (32, Fig. 2).

f. Regarding claim 15, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein said at least one button is selected from a group consisting of a button that protrudes from the alarm-clock housing (24, Fig. 1).

g. Regarding claim 16:

The combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein said alarm-clock is operated using an alternating current (32, Fig. 2).

Jones is silent as to the characteristics of the alternating current the clock is designed to use.

It is within the knowledge of a person having ordinary skill in the art that the characteristics of residential electrical power available in the United States to power devices such as the clock comprise 110/120 VAC at 60 Hz.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to additionally modify Jones such that it uses 110/120VAC power, because a person having ordinary skill in the art would recognize that the problem of providing power to the alarm clock would be easily solved if the clock were able to use the electrical power readily available in the US, and that a clock that uses readily available electrical power would have greater commercial appeal than one which required a voltage converter.

h. Regarding claim 17, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein the display of said alarm-clock is selected from a group consisting of a digital display (12, Fig. 1).

i. Regarding claim 18, the combination of Jones and Parissi teaches all that is claimed as discussed in the rejection of claim 10 above. Jones also teaches wherein at least one means is provided to control light radiating from said alarm-clock (30, Fig. 2).

(10) Response to Argument

Appellant indicates on p. 6, in the last full paragraph, that arguments have been provided pertaining to the set of claims currently under consideration, and listed on pp. 32-34, and to the set of non-entered claims, listed on pp. 35-37. The examiner's response to arguments will address only those arguments directed to the claims under consideration, and will not address arguments directed to the non-entered claims.

a) Was it proper to Reject Claims 1-6, 8, and 9 under 35 U.S.C. § 102(b) as being anticipated by Jones, Jr., (U.S. Patent No. 5,402,396)?

Appellant argues on pp. 10-14 that the rejection of claims 1-6, 8, and 9 under 35 U.S.C. § 102(b) as being anticipated by Jones should be reversed. The examiner disagrees for the reasons set forth in the rejections, and for the following reasons:

Regarding Appellant's arguments on p. 11, second paragraph, rebutting the examiner's position on the claim language "to provide a visual reminder that said alarm has been set": the examiner considers this language to be functional, and not further limiting of the scope of the claim. Whether an observer is reminded an alarm is set is immaterial to the structure of the apparatus, so long as "wherein when said alarm is set said alarm button radiates light." Jones clearly teaches that when an alarm is set, the alarm button is lighted (Jones: "to provide a night light which is switched on while the alarm is on and thus

illuminate the controls,” col. 1, ll. 37-39; “a night-light which can illuminate at least the alarm ON/OFF button and the so called sleep button when the alarm ON/OFF button is set to its ON position,” col. 1, ll. 45-47; “buttons 24, 26 be rendered translucent and for light produced by the night light be allowed to be transmitted therethrough,” col. 2, ll. 57-59).

Applicant argues on p. 13, paragraphs 3-5, that the Office is using hindsight reconstruction to reject Appellant’s application as being anticipated by Jones. Though the examiner considers these arguments to be moot, as they are applied to the non-entered claims, the examiner nonetheless wishes to address these arguments as if they were applied to the claims under consideration. The examiner disagrees with Appellant’s allegations of a hindsight reconstruction combined with the Appellant’s teaching. First, hindsight is not an issue with an anticipatory reference: either the reference teaches all of the elements of a claim, or it does not. There may be instances where an anticipatory reference teaches several related, but distinct embodiments, and in such cases, care must be taken to avoid combining elements of one embodiment with elements of another. However, this is not the case here. Jones teaches only a single embodiment, and the features of that embodiment anticipate the claim language as discussed in the rejections above. Though the night light 28 of Jones may be turned down or even off (Jones: col. 1, ll. 47-51), this is not dispositive of the fact that Jones teaches that “when said alarm is set said alarm button radiates light” (Jones: “to provide a night light which is switched on while the alarm is on and thus illuminate the controls,” col. 1, ll. 37-39; “a night-light which can illuminate at least the alarm ON/OFF button and the so called sleep button when the alarm ON/OFF button is set to its ON position,” col. 1, ll. 45-47).

Note: the examiner has not considered the following arguments, as they are directed to the non-entered claims:

- p. 10, second full paragraph, through p. 11, first full paragraph;
- p. 11, third full paragraph, through p. 14, first partial paragraph.

Regarding Appellant's argument on p. 14, with respect to claim 2, that Jones fails to teach a bulb in combination with alarm button 24, Jones teaches two light bulbs (Jones: 40, 42, Fig. 2) associated with the night light 28 (Jones: col. 2, ll. 27-31). Jones also teaches that the light from these bulbs may be transmitted through the translucent alarm button 24 (Jones: col. 2, ll. 55-59).

Regarding Appellant's argument on p. 14, with respect to claim 3, that Jones fails to teach a translucent alarm button, Jones teaches a translucent alarm button (Jones: "buttons 24, 26 may be rendered translucent," col. 2, l. 57).

Regarding Appellant's argument on p. 14, with respect to claim 4, that Jones fails to teach at least one electronic component selected from the group consisting of an AM-FM radio, Jones teaches at least one electronic component selected from the group consisting of an AM-FM radio (Jones: dial 14, showing AM and FM, Fig. 1).

Regarding Appellant's argument on pp. 14-15, with respect to claim 5, that Jones fails to teach wherein the alarm clock is operated using alternating current, Jones teaches wherein the alarm clock is operated using alternating current (Jones: AC source 32, Fig. 2).

Regarding Appellant's argument on p. 15, with respect to claim 6, that Jones fails to teach an alarm button that protrudes from the housing, Jones teaches an alarm button that protrudes from the housing (Jones: 24, Fig. 1, protrudes from the housing).

Regarding Appellant's argument on p. 15, with respect to claim 8, that Jones fails to teach wherein the display of said alarm-clock is selected from the group consisting of a digital display, Jones teaches wherein the display of said alarm-clock is selected from the group consisting of a digital display (Jones: digital display 12, Fig. 1).

Regarding Appellant's argument on p. 15, with respect to claim 9, that Jones fails to teach at least one means to control light radiating from the alarm clock, Jones teaches at least one means to control light radiating from the alarm clock (Jones: dimmer switch 30, Fig. 2).

b) Was it proper to Reject Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Jones, Jr. (U.S. Patent No. 5,402,396)?

Appellant argues on pp. 17-19 that this rejection is not proper. The bulk of the argument deals with whether Jones teaches the elements of claim 1 as discussed above, and these arguments are addressed above.

Appellant specifically addresses the claim limitations added by claim 7 on p. 18, second full paragraph, that there is no teaching in Jones that the clock be powered by a power source selected from a group consisting of an alternating current source between about 120 volts and about 240 volts. The examiner disagrees. The examiner has set forth reasons why it would have been obvious to use such a power source to power the clock of Jones. Jones teaches using an AC source, such as household current (col. 2, ll. 60-65), and one having ordinary skill in the art would know that in the US, standard household current is between about 120 and 240 volts.

c) Was it proper to Reject Claims 10-18 under 35 U.S.C. § 103(a) as being unpatentable over Jones, Jr. (U.S. Patent 5,402,396) in view of Parissi (U.S. Patent No. 2,444,748)?

To the extent that Appellant's arguments assert that Jones does not teach elements of claim 10 that are common to claim 1, the examiner refers to the above rebuttal of Appellant's arguments regarding claim 1.

Regarding Appellant's argument on pp. 22-23 that the combination of Jones and Parissi does not teach the claimed invention, and further, that Parissi teaches away, the examiner disagrees. The examiner has set forth reasons why the combination of Jones and Parissi teaches the elements of claim 10 in the rejections above. Additionally, the object of Jones is to have the alarm button lit so that one will notice that an alarm is set. Parissi teaches that a flashing alarm button is more visible to certain users, such as deaf users. One having ordinary skill would recognize that by combining the flashing alarm of Parissi with the lighted alarm of Jones, Jones' goal of providing a visual notice that the alarm is set would be enhanced.

Note: the examiner has not considered the following arguments, as they are directed to the non-entered claims:

- p. 20, last partial paragraph, through p. 11, second full paragraph;
- p. 23, first full paragraph, through p. 24, first partial paragraph.

To the extent that Appellants arguments regarding claims 11-18 assert that Jones fails to teach the claimed elements, the examiner refers to the arguments regarding claims 2-9 above. The examiner disagrees with Appellant's arguments for claims 11-18, and

asserts that the above arguments show that Jones does in fact teach all of the claimed elements.

d) Was it proper to issue a defective Advisory Action?

The amendment after final rejection filed on 22 November 2006 has not been entered. Though the Advisory Action mailed 20 December 2006 was incomplete in that neither box a) or b) in item 7 was checked, the Advisory Action indicated in item 3 that the amendment would not be entered.

As discussed in section 6, this issue is not appealable to the Board, but instead relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Leo Hinze/
Patent Examiner
AU 2854
14 February 2008

Conferees:

/Judy Nguyen/ - Supervisory Patent Examiner, Art Unit 2854

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